

REMARKS

1. In response to the Office Action mailed June 14, 2005, Applicant respectfully requests reconsideration. Claims 21-42 were last presented in this application. In the outstanding Office Action claims 27, 28, 33 and 38 were rejected; claims 30-32 and 34-36 were objected to and claims 21-27 and 38-42 were withdrawn from consideration. By the foregoing Amendments, claims 28, 30, 32, 33 and 36 have been amended, and claims 22-27, 29 and 38-42 have been cancelled. No claims have been added. Thus, upon entry of this paper, claims 28 and 30-37 will be pending in this application. Of these nine (9) claims, one (1) claim (claim 28) is independent. These Amendments are believed not to introduce new matter and their entry is respectfully requested.

Art of Record

2. Applicant acknowledges receipt of form PTO-892 identifying additional references made of record by the Examiner.

3. Applicant acknowledges receipt of the form PTO-1449 filed by Applicant on July 29, 2004, which has been initialed by the Examiner indicating consideration of the references cited therein.

Election/Restrictions

4. This application was restricted to one of the following inventions under 35 U.S.C. § 121: Group I including claims 21-27 and 38-42, drawn to a battery compartment (classified in class 429, subclass 163) and Group II including claims 28-37, drawn to a battery powered device (classified in class 429, subclass 157). Applicant affirms that on April 6, 2005, Applicant elected without traverse to prosecute the invention of Group II (claims 28-37). Claims 21-27 and 38-42 have been cancelled without prejudice or disclaimer by the foregoing Amendments. Applicant reserves the right to pursue the subject matter of the cancelled claims in a continuation/divisional application.

Allowable Subject Matter

5. Applicant notes with appreciation the Examiner's indication that claims 30-32 and 34-36 would be allowable if rewritten to include the limitations of their respective base claims and any intervening claims.

Claim Rejections

6. Independent claim 28 and dependent claims 29 and 33 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,050,053 to McDermott (hereinafter, "McDermott"). Also, claim 37 has been rejected under 35 U.S.C. §103(a) as being unpatentable over McDermott in view of U.S. Patent No. 6,708,887 to Garrett et al. (hereinafter, "Garrett"). Specifically, the Examiner rejected claims 28, 29 and 33 as being anticipated by McDermott based upon McDermott's use of a compressible coiled spring in a battery compartment. The Examiner refers Applicant to column 7, lines 1-5 of McDermott in support of this contention. Applicant respectfully traverses these rejections.

7. Claim 28 has been amended to recite "[a] battery-powered device comprising: a battery compartment ...; and means for rupturing an insulating contaminant layer disposed on portions of at least one terminal of at least one battery installed in the battery compartment. (See, amended claim 28, above.) In contrast to rupturing the insulating contaminant layer, McDermott reduces contact resistance by increasing the surface area of the coiled spring 84 that comes into contact with the battery terminal. Specifically, the multiple turns of the McDermott coiled spring 84 "collapse upon the battery return surface 57." (See, McDermott, col. 4, lns. 56-68; Figs. 11, 12 and 16.)

8. In fact, there is no teaching or suggestion in McDermott indicating a recognition of the presence of a contaminant layer on the battery terminal, nor that removal of such a layer would decrease contact resistance. The Examiner's reliance on an "insulating layer" in McDermott is, in actuality, the casing of the battery. (See, McDermott, col. 4 , lns 53-58; Fig. 6.)

9. The Examiner further asserts that the coiled spring of McDermott would have inherent capabilities to puncture an insulating contaminant layer on a terminal of a battery installed in the McDermott device. Applicant disagrees.

10. McDermott fails to meet the requirement articulated in the MPEP that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill..." (See, MPEP 2112, citing *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (See, MPEP 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).) It is stated *In re Robertson*, (CAFC) 49 U.S.P.Q. 1949, 1951 (1999) that "To establish inherency, the "evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) the Court states that "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." (*Id.*)

11. The coil spring of the McDermott device has its largest diameter abutting the insulated casing 16 of the battery while the smallest diameter contacts either the inner conducting surface of the casing, or a control plug and pocket clip 41. As the end of the light is turned the spring windings collapse on the negative terminal of the battery on which it is resting. (See, McDermott, col. 4, lns. 14-46.) Therefore, the windings of the spring resting on the battery have no need for movement once they contact the negative terminal, but rather remain stationary while the end of the spring having the smallest diameter moves directly toward the battery. Since McDermott decreases contact resistance by increasing the surface area of the spring that contacts the battery, any lateral movement of the spring could bring it out of maximum contact with the battery, thereby reducing the decrease in resistance. Lateral movement would therefore be contradictory to the teachings of the McDermott patent. There is also insufficient pressure applied by the spring to rupture the contaminant layer. Figures 2, 5, 12, 16 and 37 all show the McDermott device in the "on" position with the spring in the compressed state. In none of these figures is the case in contact with the battery thereby indicating that the design as taught by McDermott does not apply sufficient pressure to cause any portion of the spring, or any other element, to rupture the contaminant layer. Further, each coil winding of the spring brought to rest on the battery is smooth.

12. Accordingly, the only inherent operation which can be derived from McDermott is that the compressible coiled spring is capable of performing the purpose intended by McDermott; that is, to provide adequate surface contact area so that an electrical connection may be established with an installed battery. There is no express, implicit or inherent

disclosure in McDermott regarding a feature or characteristic of the McDermott device that indicates that it necessarily ruptures an insulating contaminant layer on the terminal surface of an installed battery.

13. For at least the above reasons, Applicant respectfully asserts that there is no express, implicit or inherent disclosure in McDermott indicating that the McDermott device performs the alleged function recited in Applicant's claim 28. Applicant therefore respectfully asserts that the rejection of independent claim 28 based on the inherent features of McDermott is improper and should be withdrawn.

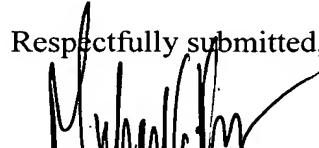
Dependent Claims

14. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them a *fortiori* and independently patentable over the art of record. Accordingly, Applicant respectfully requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

15. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,


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